

Remarks/Arguments

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Rejections Under 35 U.S.C. §103(a)

The Office Action rejected the claims 1, 3-8, 13, 17-26, 32-34, 37, 40-41, 43-46, 49-50, 53-54, 57-66, 69-70, 72-73, 77, 80-81, 83-86, 89-90, 93-94, 97 and 99-103 under 35 U.S.C. §103(a) as being unpatentable over Montenegro et al. (US 5,694,537) in view of Seazholtz et al. (US 6,246,875 B1). Applicant respectfully disagrees.

MPEP (2143.03) provides

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) 2143.03).

Applicant's independent claims 1, 17, 37, 57, 77 and 97 include claim limitations that are not discussed nor suggested by the References. Therefore, Applicant's independent claims are patentable over the References.

In particular, Applicant's independent claims include the claim limitation, or limitation similar thereto, of:

*“a first logic unit to provide a list of service providers via a communication connection, indicating a real-time availability and **a rate** of at least one service provider of the service providers;*
*a second logic unit to **receive from a user a selection** of a service provider from the list of service providers;*

... and wherein the service provider is an information provider"

(Independent claim 1)

1) References Do Not Show "Receive From A User A Selection"

The Examiner states in the Office Action that Montenegro discloses a system comprising a second logic unit to receive from a user a selection of a service provider from the list of service providers. Applicant respectfully disagrees. Rather, Applicant asserts that there is no suggestion or teaching in Montenegro to "receive from a user a selection of a service provider", as recited in applicant's independent claim 1.

The Examiner cites specifically in Montenegro,

"FIG 5 is a flow diagram which shows process steps of the present invention for selecting a time service provider... A highest priority time service provider is available in the list identifying plural time service providers is determined via a LAN interface, ... and the highest priority time service provider which is available in the list ... is selected via the LAN interface. ...

In a preferred embodiment, (1) IPX (Novell time service provider 9) (2) TCP/IP (Unix time server) ... the plural time servers being in order of priority from highest priority time service provider (IPX) to lowest priority time service provider (AppleTalk). In step 502, the network administrator may change the default time update interval or the default order of priority of time service providers in the list of plural time service providers."

(Column 8 lines 10-46)

As shown above, in Montenegro, a time server is chosen based on its listed priority, where the priority of the servers is predetermined. A network device in Montenegro determines availability of time servers and selects the highest priority time server which is available. Therefore, the network device is able to access time data even if one or more time service providers in the list become unavailable. The process of selecting a time server is determined by a software program stored in an EPROM, not by a user.

For example, in Montenegro:

“FIG.4 illustrates examples of blocks of code, or software modules, that are stored in EPROM 42. ... The CPSOCKET program runs for all protocol stacks. ... As shown in FIG. 4, CPSOCKET contains process steps for selecting a time service provider from a list of plural time service providers... ” (Column 5 lines 34-35 and Column 6 lines 15-16 and 29-33)

Thus, the list of time servers discussed in Montenegro ensures accessibility of time data in the event that some time servers are down by selection of the highest priority time server that is available **based on process steps contained in a software module, the CPSOCKET program**. A user is not involved in the selection process.

Applicant’s independent claim recites “*a second logic unit to receive from a user a selection of a service provider from the list of service providers*”. For example, the specification of the present application provides: “customers will have the option of executing a keyword search for service providers ... in one embodiment, customers will view a list of service providers matching the keyword search criteria on a web page presented by the logic unit on the customer computer. ... a logic unit within the system presents, in response to a customer selection of a service provider from the list, a listing page that contains additional information about the selected service provider and the selected information service” (see, e.g., Specification of the present application, page 10, lines 2-25).

Thus, Montenegro does not suggest, teach, or motivate “to receive from a user a selection of a service provider” as recited in Applicants’ independent claims.

Seazholtz was cited for alternate limitations recited in the independent claims. Seazholtz does not show the corresponding limitations discussed above for the independent claims. Further, Seazholtz suggests that it is time consuming and impractical for a customer to select a service carrier from a list while roaming, further teaching away from limitations of Applicant’s independent claims.

Thus, when viewed together, Montenegro and Seazholtz do not show each and every aspect of the independent claims.

2) Cited References Cannot be Validly Combined in a Way Suggested in the Office Action

The Examiner admits that Montenegro fails to disclose a first logic to provide a list of service providers indicating a real-time availability and a rate of at least one service provider of the service providers. However, the Examiner states that “it would have been obvious to one of the ordinary skill in the art at the time of the invention was made to modify the invention of Montenegro using the teaching of selecting a service provider as taught by Seazholtz” through enabling the system to “provide a list of service providers indicating a real-time availability and a rate of each at least one service provider so that the user would have a wireless communication while roaming.” Applicant respectfully disagrees.

As previously discussed, Montenegro describes a network device to access plural time servers in a list based on the listed priority and availability to access ‘time data’, even if one or more time servers in the list become unavailable. However, Seazholtz discusses a list of ‘service carriers’ operating within a geographical area, where an available service carrier can be selected by a subscriber station relating to methods for efficiently registering cellular subscriber stations with a service carrier. The ‘service carrier’ discussed in Seazholtz does not provide the

functionality of a ‘time server’ required in Montenegro, since the ‘service carrier’ in Seazholtz is a cellular carrier that provides cellular servicing but the ‘time server’ is a server that provides time. Thus, there is no reasonable expectation of success for combining Montenegro and Seazholtz in a way suggested in the Office Action. There appears no reason to use the ‘service carrier’ of Seazholtz in the system of Montenegro. Thus, the combination suggested in the Office Action is solely for the purpose of bridging the gaps between Montenegro and the invention as claimed, not based on the teaching of the cited references.

Therefore, the withdrawal of the rejection based on the combination suggested in the Office Action is respectfully requested.

3) Combination Does Not Show: “indicating a real-time availability and a rate of at least one service provider of the service providers”

Not only is there a lack of reasonable chance of success to combine Montenegro and Seazholtz, Seazholtz does not cure the deficiency of Montenegro failing to disclose a first logic to provide a list of service providers indicating a real-time availability and a rate of at least one service provider. Seazholtz discusses the use of cellular digital packet data communications to convey system identification list data to roaming cellular subscriber stations. For example, a roaming subscriber can tune to a cellular digital packet data frequency to obtain a list of service carriers operating within that geographical area. While a list of operating service carriers may be provided, the rate of a service provider is not indicated on the list, as described below in detail. For example, in Seazholtz,

“While roaming, a customer is unlikely to know the rates charged by the competing foreign cellular systems. Moreover, the rate structures may be complicated, and they may change from time to time ... Thus when a customer is roaming, he or she typically does not possess sufficient information upon which to base an intelligent

*foreign cellular system selection decision... Typically **the subscriber** **does not desire** to go to the time and trouble to obtain this information, and make the necessary alterations in the operation of the cellular subscriber station.” (Column 3 lines 58-67)*

As shown, Seazholz specifically indicates that a rate of a service provider (“competing foreign cellular systems”) is **unlikely to be known** since the rate information is not provided because of the complex and varying nature of the rate structure of the service provider.

Further, Seazholz indicates that it is not desirable to obtain this information and thus teaches away from the limitation of ‘provide **a list** of service providers ..., **indicating** ... and **a rate** of at least one service provider of the service providers’, which is recited in Applicant’s independent claims.

Seazholtz merely discusses lower usage rates provided by service carriers in certain contractual relationship, but fails to suggest or motivate listing the rate of the service provider in a list of service providers.

For example, the Examiner cites in Seazholtz,

“the SIDs (system identification numbers) of the scanned signals have been selected and stored are compared with a list of SIDs for preferred system providers. Such system providers or carriers usually have a special contractual relationship.. so that the subscriber receives preferential treatment, normally in the form of lower usage rates” (Column 15 lines 4-23)

“the RSSI of the selected SID is compared with that of all the other received SIDs to determine if the RSSI of the selected SID is the highest ... if the selected SID is within the tolerance ranges dictated for the step at 602, then the control frequency carrier of the system

provider corresponding to the selected SID is acquired by the subscriber station and registration carried out.” (Column 17 lines 17-36)

In Seazholtz, the RSSI (received signal strength indication) of an SID is a measure of the received radio signal strength of the SIDs of each channel. The RSSI is determined by signal intensity and the energy that a signal carries, and is unrelated to a **rate** of a service provider recited in applicant’s independent claims 1, 17, 37, 57, 77 and 97.

4) Combination Does Not Show: “live person to provide information about the service provider ” for dependent claims 6, 26, 46 and 86

Regarding dependent claims 6, 26, 46, and 86, Examiner asserts in the Office Action that Montenegro discusses a system, wherein information of the information provider is provided as a communication with a live person. Applicant respectfully disagrees.

The Examiner cites in Montenegro,

“the network administrator may change the default time update interval or the default order of priority of time service providers in the list of plural time service providers.” (Column 8 lines 46-50)

Montenegro merely discusses changing of priority of time servers in a list by a network administrator, who does not act as a live person to provide information of the information provider. While the network administrator may be a ‘person’, the network administrator does not provide “a communication” as “a live person”. In Montenegro, there is no indication that the information provided by the network administrator is in the form of “a communication with a live person”.

Therefore, Montenegro does not disclose the additional feature recited in Applicant's claims 6, 26, 46, and 86.

Further, Seazholtz was cited for alternate limitations recited in the independent claims. Seazholtz does not show the corresponding limitations discussed above for the dependent claims 6, 26, 46, and 86. Thus, when viewed together, Montenegro and Seazholtz do not show each and every aspect of the independent claims.

Therefore, since applicant's independent claims 1, 17, 37, 57, 77 and 97 have claim limitations that are not disclosed in, nor suggested by, the cited references, Applicant's independent claims are patentable over the cited references at least for the above stated reasons. Applicant's remaining claims depend from one of the foregoing independent claims and therefore incorporate the distinguishing limitations of the foregoing independent claims. Therefore, the remaining dependent claims are also patentable over the cited references. Thus, the withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

Respectfully submitted,

Date: February 5, 2007

/JOHN P. WARD/
John P. Ward
Reg. No. 40,216

GREENBERG TRAURIG, LLP
CUSTOMER NUMBER 56188
1900 University Avenue, Fifth Floor
East Palo Alto, CA 94303
Phone: (650) 328-8500
Fax: (650) 328-8508
E-Mail: wardj@gtlaw.com